



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,598	06/27/2003	Ben Huang	WINN.001A	2270

20995 7590 09/27/2006

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT	PAPER NUMBER
----------	--------------

3711

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/608,598

Applicant(s)

HUANG, BEN

Examiner

Stephen L. Blau

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
4a) Of the above claim(s) 25-31 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-24 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 5/12/06, 5/24/06 → 8/23/06
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Request for Continued Examination

1. The request filed on 12 May 2006 for a Request for Continued Examination (RCE) under 37 CFR 1.53(d) based on parent Application No. 10/608,598 is acceptable and a RCE has been established. An action on the RCE follows.

Information Disclosure Statement

2. The information disclosure statement filed 12 May 2006 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the court papers are not relevant to the processing of this case. During the litigating process of a prior patent, if prior art or other information material to the patentability of pending claims is discovered that is relevant to a pending case at the patent office the applicant is required to disclose this discovery under 37 CFR 1.97, 37 CFR 1.98, and 37 CFR 1.56. However it is neither desired nor required to submit to the Patent Office every declaration, objection, answer, order, reply, opposition, deposition transcript etc... that is filed in a court litigating a previous patent. Since it appears that every court paper is being submitted on a civil cases of other patents owned by the applicant it is clear no thought is being given to the information as it relates to the pending claims of this case. In fact most of these papers are not even prior art in that they are being submitted almost two

Art Unit: 3711

years after the filing date of this case (6/27/03). In this application there are over 5000 pages of court papers which the applicant is asking the Examiner to review. This is an intense burden on the examiner. Litigating the validity of patents in courts is a completely different process compared to processing a patent application at the U.S. Patent Office. Courts have no set time to decide a case while at the Patent Office the processing of a case is limited by time. In this particular art for this case the examiner has only 6 hours to read and understand an invention, review disclosed prior art, perform a search and write a position for a first office action. Clearly reviewing 5000 pages of court papers that were submitted in this case with no logic related to the relevance of the claims of this pending application would take a significant portion of this 6 hours if not the entire allotted time or more the examiner has to complete a first office action. And as the litigating process continues the examiner sees no end point to the number of pages of court papers which will be submitted in this case or future cases. If every attorney practicing before the Patent Office did the same as being done in the cases the applicant has before the Patent Office, it would bring the Patent Office to a complete stop in terms of being able to perform its job. Plus the examiner thinks it inappropriate to comment on papers being filed during the litigation of a patent before a court since the approval of patents at the Patent Office and the litigation of the validity of patents in the court are two independent and different processes with different procedures, standards and time frames. It is not the examiner's roll to comment on every court paper which is being submitted before a court. In the past it has been the practice for applicants to use court decisions to argue cases before the Patent Office

Art Unit: 3711

and not tie up the Patent Office with court papers that will be used to decide cases before a court. As such, due to the nonsensical submission of court papers in this case the examiner will not consider court papers on Information Disclosure Statements filed by the applicant.

2. The information disclosure statement filed 12 May 2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. In a petition also filed 12 May 2005 it was stated that copies of these references could be found in application 10/167,216. The examiner could not find any IDS filed in case 10/167,216 for references ZL 02254450 X, FR 2,731,402 and WO 2005/115563 A1. The PRO-SB-08 has been placed in the application file, but the information referred to therein for these references has not been considered.

Art Unit: 3711

3. The Supplemental Information Disclosure Statement dated 3 August 2006 has been considered. The Examiner appreciates the offer to provide docket sheets for these litigations if requested. As of this time the Examiner sees no need to review them.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 4, 6-11, 13-16, 19, 22 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yeh in view of Yasui and Shirono.

Yeh discloses a grip formed of an elongated strip comprising an elastomer (Col. 2, Lns. 52) layer (12) bonded (Claim 1) to a felt layer (Col. 2, Lns. 54-56), an elastomer being a thermoplastic urethane, thermoplastic rubber (Col. 2, Lns. 51-56), and a polyurethane (Col. 2, Lns. 51).

Yeh lacks a powdered inorganic antimicrobial agent dispersed in an elastomer, an antimicrobial agent of silver in a porous based carrier of a silica-alumina carrier and the concentration by weight of an inorganic antimicrobial agent being about 2%. Yasui discloses an antibacterial material in an elastomer grip formed from synthetic resin (Col.

Art Unit: 3711

2, Lns. 61-64), synthetic resins including by not limited to rubber based elastomers, urethane rubber, and thermoplastic elastomers (Col. 2, Lns. 65 through Col. 3, Ln. 7), a grip (Col. 1, Lns. 21-27) for sporting equipment in the form of a fishing pole (fig. 1), antibacterial and antifungal material (Col. 2, Lns. 61-64) in the form of pellets (Col. 1, Lns. 65-67) of inorganic material of silver in a porous (Col. 1, Lns. 53-56) silica-alumina or zeolite carrier (Col. 3, Lns. 8-20), BACTEKIRANI, NOVALON (Table 1), resin being formed by melting synthetic resin with antibacterial pellets (Col. 1, Lns. 65-67) and the concentration by weight of an inorganic antimicrobial agent is from .2 to 3 % (Tables 1-2) in order to cause less skin irritation and offer improved durability (Col. 3, Lns. 8-20). Yasui does not specifically state that the antibacterial agent is dispersed in the synthetic resin but clearly one skilled in the art of forming a molded composite grip with pellets of antibacterial agents in would have located the pellets in a suitable location in which dispersed therein is included. Shirono discloses an inorganic antimicrobial agent being a powdered in the form of a metal being carried on zeolite (Col. 1, Lns. 5-14) as Yasui teaches. Clearly the art interchanges the terms of a pellet and a powder for an inorganic antimicrobial agent when a metal is carried on a carrier. In view of the patent of Yasui it would have been obvious to modify the sporting golf grip of Yeh to have a synthetic resin grip made of thermoplastic rubber, urethane layer or a polyurethane layer comprising silver metal in a porous silica-alumina or zeolite carrier having a concentration by weight of an inorganic antimicrobial agent being about 2% in order have a golf grip with anti bacterial and antifungal properties and in order to cause less skin irritation and offer improved durability for golf grip having an elastomer having an

Art Unit: 3711

antibacterial agent while playing a round of golf. In view of the patent of Yasui it would have been obvious to modify the sporting golf grip of Yeh to have the antimicrobial agent dispersed therein the elastomer in order to ensure the agent is throughout the elastomer providing antimicrobial protection instead of at only one portion of the grip material. In view of the patents of Yasui and Shirono it would have been obvious to modify the grip of Yeh to have the inorganic antimicrobial agent comprising a powder in order to utilize a form of an inorganic antimicrobial agent used in the market place.

6. Claims 12, 17-18, 20-21 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yeh in view of Yasui and Shirono as applied to claims 1-2, 4, 6-11, 13-16, 19 and 22 above, and further in view of Hayashi.

Yeh lacks an inorganic antimicrobial silica-alumina being montmorillonite having the formula as defined by claim 12. Yasui discloses inorganic material of silver in a porous (Col. 1, Lns. 53-56) silica-alumina or zeolite carrier (Col. 3, Lns. 8-20). Shirono discloses an inorganic antimicrobial agent being a powdered in the form of a metal being carried on zeolite (Col. 1, Lns. 9-11). Hayashi discloses a suitable substitute for an inorganic antimicrobial of silver in a zeolite carrier being silver in a montmorillonite carrier (Col. 3, Lns. 42-49). In view of the patent of Hayashi it would have been obvious to modify the grip of Yeh to have an inorganic antimicrobial agent being silver in a montmorillonite carrier in order to utilize an inorganic antimicrobial agent available in the market place if metal being carried on zeolite was not available. As such the carrier would have the formula as defined by claim 12 [0027].

7. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yeh in view of Yasui and Shirono as applied to claims 1-2, 4, 6-11, 13-16, 19 and 22 above, and further in view of Huang (5,695,418).

Yeh discloses a textile layer have an adhesive layer in the form of a double sided adhesive tape (Col. 1, Lns. 33-39) and a polyurethane (Col. 2, Lns. 51).

Yeh lacks a polyurethane having closed pores that extend vertically in a direction normal to a longitudinal axis of a strip and a protective quick-release tape. Huang discloses a grip being an elongated strip (Fig. 5), a grip tape with polyurethane having closed pores that extend vertically in a direction normal to a longitudinal axis of a strip in order to have enhanced compression (Col. 4, Lns. 8-20), an adhesive layer, and a protective quick-release tape (Fig. 4). In view of the patent of Huang it would have been obvious to modify the grip of Yeh to have a grip tape with polyurethane having closed pores that extend vertically in a direction normal to a longitudinal axis of a strip in order to have enhanced compression when gripping a polyurethane grip. In view of the patent of Huang it would have been obvious to modify the grip of Yeh to have a protective quick-release tape in order to prevent the strip adhesive form sticking on things until it is ready to be placed on a handle.

Response to Arguments

8. The argument that it is improper to use the reference of Shirono due to Shirono not disclosing a powder agent but a colloidal solution of inorganic oxide is disagreed with. The examiner was not using the invention of Shirono but what Shirono disclosed as prior art to show that it is known to have an antibacterial agent in powder form (Col. 1, Lns. 11-15). The argument that it is improper to use Shirono due to Shirono pointing out numerous problems associated with powdery antibacterial compositions and provides a solution to powdery compositions is disagreed with. Even though Shirono points to the disadvantages of the powdery antibacterial compositions it does not negate the fact that they exist and others have thought them to be advantageous to use though Shirono at the time of filing may not. The argument that the Applicant's invention for the first time disclosed unexpected and successful use of powder inorganic antibacterial agent is disagreed with. Shirono clearly discloses that it is known to have a powder inorganic antibacterial agent (Col. 1, Lns. 11-15). The argument that it is improper to combine Yeh and Yasui because they are directed toward different uses of grips made of elastomer is disagreed with. Both are grips used for holding shafts of sporting equipment. Both of these uses of grips are concerned with the same objectives as comfort while compressing a shaft and reducing slipping between the hands and shaft as well as size. The examiner believes it is very logical to look at tennis grips, bat grips, fishing pole grips, ski pole grips, bicycle grips, etc., since teachings benefiting one use of a grip will most likely benefit other uses of grips for the

Art Unit: 3711

same reason. After a person discovers a new type of grip it does not seem reasonable that the Patent Office should issue another patent to another person only because the use of the grip has been changed. The argument that it is improper to combine Yeh and Yasui because Yeh is concerned with improved moisture absorption in a racquet grip and Yasui provides antibacterial property in fishing poles is disagreed with. There are other similar properties and concerns that though not mentioned by these references are old and well known in the art as hand comfort when compressing the hands around a shaft and nonslip characteristics. Clearly both Yeh and Yasui are concerned about these features though it may not be specifically discussed. Both of these grips have enough similarities in purpose and materials to share teachings between. The argument that it is improper to use the reference of Yeh due to Yeh not discussing microbial infestation is disagreed with. Throughout the prosecution of this case the examiner has cited other golf grips where this problem is being discussed for golf grips. Though Yeh does deal with this problem prior art does teach that this is a problem for golf club grips also. The argument that it is improper to combine Yeh and Yasui due to Yasui being a molded grip and Yeh being a thin layer of polymeric material with a longitudinal axis wrapped helically around a handle is disagreed with. The grip tape of Yeh has to be made and molding would be a very obvious process for a tape as well. Yeh makes both layers separately and then attaches them unlike other methods as the applicant uses in making multilayer tape material. Plus antibacterial substances have been placed in golf grips in the form of a tape before though not the same substance (9-75480). The argument that it is improper to combine the reference of Yeh

Art Unit: 3711

and Yasui due to the pellets and method of Yasui is incompatible with the Applicant's process of polymerizing is disagreed with. The claims do not require the polymerization process the Applicant uses. Clearly there are other ways to make a polyurethane layer attached to a textile layer as stitching and using an adhesive.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Blau whose telephone number is (571) 272-4406. The examiner can normally be reached on Mon - Fri 10:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SLB/19 September 2006



STEPHEN BLAU
PRIMARY EXAMINER